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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAI V. ALLAVARPU, RAJEEV ANGAL, and TONY T. VUONG

Appeal 2009-000758
Application 09/553,970
Technology Center 2100

Decided: November 20, 2009

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-15, 17-37, 39-58, and 60-64. Claims 16, 38, and 59 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We Affirm-in-part.

STATEMENT OF THE CASE

INVENTION

The invention on appeal is directed generally to computer software. More particularly, Appellants' invention is directed to software for debugging computer programs. (Spec. 1).

ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A thread-safe debugging system comprising:
 - a thread-safe debug service which is executable on a client computer system to provide debug services to debug a multi-threaded application which is executable on the client computer system; and
 - a thread-safe remote control service which is executable on the client computer system to receive control requests from an external source to initiate and manage the debug services on the client computer system after initiation of the multi-threaded application.

PRIOR ART

The Examiner relies upon the following references as evidence:

Wygodny	US 6,282,701 B1	Aug. 28, 2001
Kaler	US 6,467,052 B1	Oct. 15, 2002

THE REJECTIONS

1. The Examiner rejected claims 1-7, 9-15, 17, 20-28, 30-37, 39, 42-50, 52-58, 60, 63, and 64 under 35 U.S.C. § 102(e) as anticipated by Wygodny.
2. The Examiner rejected claims 8, 29 and 51 under 35 U.S.C. § 103(a) as unpatentable over Wygodny.
3. The Examiner rejected claims 18, 19, 40, 41, 61 and 62 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wygodny and Kaler.

GROUPING OF CLAIMS

1. Appellants argue claims 1, 9, 10, 13-15, 17-20, 22, 30-32, 35-37, 39-44, 52, 53, 56-58, and 60-63 as a group (App. Br. 6-9). The Examiner rejected each of these claims under § 102 as being anticipated by Wygodny, except dependent claims 18, 19, 40, 41, 61 and 62, which the Examiner rejected under § 103 over the Wygodny reference. We particularly note that the third-stated rejection under § 103 of claims 18, 19, 40, 41, 61 and 62 is not argued separately (Appellants have grouped claims 18, 19, 40, 41, 61 and 62 with claim 1). Therefore, these arguments have been waived.¹ Accordingly, we

¹ See 37 C.F.R. § 41.37(c)(1)(vii) (“Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.”).

- will accept Appellants' grouping and treat claims 9, 10, 13-15, 17-20, 22, 30-32, 35-37, 39-44, 52, 53, 56-58, and 60-63 as standing or falling with independent claim 1.
2. Appellants argue claims 2-4, 23-25, and 45-47 as a group (App. Br. 9-10). We will, therefore, treat claims 3-4, 23-25, and 45-47 as standing or falling with dependent claim 2.
 3. Appellants argue claims 11, 33, and 54 as a group (App. Br. 13-14). We will, therefore, treat claims 33 and 54 as standing or falling with dependent claim 11.
 4. Appellants argue claims 12, 34, and 55 as a group (App. Br. 14-15). We will, therefore, treat claims 34 and 55 as standing or falling with dependent claim 12.

APPELLANTS' CONTENTIONS

Regarding the aforementioned groups, Appellants contend that certain claim limitations are not disclosed by the Examiner proffered combination of Wygodny and Kaler. (App. Br. 8-15). We have enumerated the specific claim limitations argued by Appellants in the ISSUES section *infra*. We address Appellants' specific arguments for each issue in our ANALYSIS section *infra*.

EXAMINER'S RESPONSE

The Examiner maintains that the limitations argued by Appellants are described or taught by Wygodny under § 102 or § 103, or by the combination of Wygodny and Kaler under § 103. (Ans. 3-10).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Under § 102(e), have Appellants shown that the Examiner erred in rejecting representative claim 1 by finding that Wygodny describes: “receiv[ing] control requests from an external source?” (Claim 1).
2. Under § 102(e), have Appellants shown that the Examiner erred in rejecting representative claim 2 by finding that Wygodny describes: “an independently operable debug print function for one or more threads of the multi-threaded application?” (App. Br. 10, ¶1).
3. Under § 102(e), have Appellants shown that the Examiner erred in rejecting representative claim 11 by finding that Wygodny describes: “the remote control service is operable to allow a remote source to switch the debug services on and off for each of the corresponding components of the multi-threaded application by referencing each of the corresponding debug objects by name?” (Claim 11; *see also* App. Br. 14, ¶3).

4. Under § 102(e), have Appellants shown that the Examiner erred in rejecting representative claim 12 by finding that Wygodny describes: “the remote control service is operable to allow a remote source to switch the debug services on and off for a set of the corresponding components of the multi-threaded application by specifying a pattern to select a set of the debug objects by name?” (Claim 12; *see also* App. Br. 18, ¶4).

PRINCIPLES OF LAW

Anticipation under § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (citations omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Brief to show error in the Examiner’s proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

THE WYGODNY REFERENCE

1. Wygodny discloses a bugtrapper agent 104 that includes a bugtrapper trace library 124 on the agent side. (Fig. 1B, col. 5, ll. 46-50).
2. Wygodny discloses a client 102 that includes a traced user application and a bugtrapper trace library, each shown on the client side (Fig. 1B, col. 5, ll. 41-43).
3. Wygodny discloses that commands (e.g., START/STOP TRACE) are sent from the agent side to the client side (Fig. 1B).
4. Wygodny discloses a remote mode where the user is located remotely relative to the developer, and an agent 104 executes on the client to trace the client (col. 6, ll. 21-24, 34).

ANALYSIS

At the outset, we consider Appellants' arguments in the Brief only to the extent that such arguments are directed to claimed subject matter.

ISSUE 1

We decide the question of whether Appellants have shown the Examiner erred in finding that Wygodny describes or discloses "receiv[ing] control requests from an *external* source" (Claim 1, emphasis added).

As a matter of claim construction, we conclude that the scope of the disputed claim term “external source” is broad because it does not identify a particular point of reference or specific entity that the source is “external” to. As pointed out by the Examiner, Wygodny discloses a bugtrapper agent 104 that includes a “bugtrapper trace library 124 on the agent side. (FF 1). Wygodny also discloses a client 102 that includes a traced user application and a bugtrapper trace library on the client side. (FF 2). In addition, Wygodny discloses that commands (e.g., START/STOP TRACE) are sent from the agent side to the client side (Fig. 1B). The Examiner reads the claimed “control requests” on these commands. (Ans. 4).

We observe that the claimed “remote control service . . . is executable on the client computer system” Therefore, we conclude that what is considered as “external” or “remote” is subject to a broader reasonable interpretation than the interpretation argued by Appellants. Because Wygodny has independently labeled the client side and the agent side, and given the breadth of the argued claim language (“external source”), we find the evidence supports the Examiner’s position as articulated on pages 5-6 of the Answer.

Therefore, we find Appellants have not met their requisite burden of providing evidence or argument to show error in the Examiner’s finding of anticipation over Wygodny. Accordingly, we sustain the Examiner’s anticipation rejection for representative claim 1. Claims 9, 10, 13-15, 17, 20, 22, 30-32, 35-37, 39, 42-44,² 52, 53, 56-58, 60, 63, and 64 fall therewith as being anticipated by Wygodny.

² Regarding independent claim 44 (directed to a “carrier medium”), we note

Since Appellants have not presented separate arguments with respect to claim 21 (rejected under § 102), or claims 18, 19, 40, 41, 61 and 62 (rejected under § 103), these arguments have been waived. See Note 1 *supra*. Therefore, we *pro forma* sustain the Examiner's rejection of claim 21 as being anticipated by Wygodny, and we likewise sustain the Examiner's rejection of claims 18, 19, 40, 41, 61 and 62 as being unpatentable over Wygodny. *See In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the Board before they can be argued on appeal).

ISSUE 2

We decide the question of whether Appellants have shown the Examiner erred in finding that Wygodny describes or discloses the argued limitations of “an independently operable debug print function for one or more threads of the multi-threaded application?” (App. Br. 10, ¶1).

that our reviewing court has held that transitory, propagating signals, such as carrier waves, are not within any of the four statutory categories (process, machine, manufacture or composition of matter). *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007), *reh'g denied en banc*, 515 F.3d 1361 (Fed. Cir. 2008), and *cert. denied*, 129 S. Ct. 70 (2008). Here, Appellants disclose that the claimed “carrier medium” includes, *e.g.*, “storage or memory media . . . as well as transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed by a communication medium such as network 108 and/or a wireless link.” (Spec. 26-30). *Cf. Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1329 (Fed. Cir. 2003); *see also* MPEP § 2106(C)(2)(2)(a) (“[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.”).

Appellants contend that Wygodny fails to teach a debug print function that provides debug output, as claimed (*Id.*).

The Examiner finds that Wygodny *inherently* teaches the argued “debug print function,” as the Examiner considers Wygodny’s disclosure of displaying to encompass a monitor or *any other output display device* (Ans. 8, ¶1).

However, we conclude that a broad but reasonable interpretation of Appellants’ claimed “debug print function” requires more than merely sending display output to a printer. As argued by Appellants, the “debug print function” must also be independently operable for one or more threads of the multi-threaded application (App. Br. 10, ¶1). We note that “[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999) (internal citations omitted).

This reasoning is applicable here. The Examiner has not pointed to any specific disclosure of a “debug print function” in Wygodny, and we find insufficient evidence in the record before us to reasonably support a finding of inherency. Therefore, we reverse the Examiner’s anticipation rejection of claim 2 and claims 3-7 that depend therefrom. Because claims 23 and 45 each recite commensurate limitations, we also reverse the Examiner’s anticipation rejection of claims 23-28 and 45-50 for the same reasons discussed above regarding claim 2.

Because claims 8, 29, and 51 (rejected under §103 over Wygodny) depend from claims 2, 23, and 45, respectively, we also reverse the Examiner’s obviousness rejection of claims 8, 29, and 51.

ISSUE 3

We decide the question of whether Appellants have shown the Examiner erred in finding under § 102 that Wygodny describes the remote control service is operable to allow a remote source to switch the debug services on and off for each of the corresponding components of the multi-threaded application by “referencing” (claim 11) or “specifying” (claim 12) each of the corresponding debug objects by name. (Claims 11 and 12; *see also* App. Br. 14, ¶¶3-4).

We begin our analysis by noting that claims 11 and 12 differ only with respect to one word: “referencing” (claim 11) versus “specifying” as recited in claim 12. Based upon our review of the evidence before us, we find Wygodny discloses both “referencing” and “specifying,” as claimed, for the reasons discussed *infra*.

Appellants ground their argument on the premise that Wygodny teaches that tracing is turned on or off *locally* instead of being turned on or off *remotely* (App. Br. 14, ¶¶3-4).

However, we note that the language of claim 1 (from which claims 11 and 12 each indirectly depend) is directed to a “remote control service which is executable on the client computer system” Thus, in Appellants’ own invention, the remote control service is capable of executing on the client side, even though it is labeled in the claim as being “remote.” (Claim 1). Therefore, we conclude that the argued “remote” feature is subject to a broader reasonable interpretation than the meaning imputed by Appellants’ arguments.

Turning to the Wygodny reference, we particularly note that Wygodny discloses a remote mode where the user is located remotely relative to the developer, and agent 104 executes on the client to trace the client (FF 4). The Examiner has pointed to the check boxes shown in Wygodny's Figures 5 and 7 as disclosing the claimed switching function. (Ans. 8). Based on the breadth of Appellants' claim language, we find the weight of the evidence supports the Examiner's position. Therefore, we sustain the Examiner's rejection of claims 11 and 12 as being anticipated by Wygodny. For the same reasons, we sustain the Examiner's anticipation rejection over Wygodny of claims 33, 34, 54, and 55 that recite commensurate limitations.

CONCLUSION

Given our findings of facts and analysis set forth above, Appellants:

1. have not established the Examiner erred in rejecting claims 1, 9-15, 17, 20-22, 30-37, 39, 42-44, 52-58, 60, 63, and 64 under 35 U.S.C. § 102(e).
2. have established the Examiner erred in rejecting claims 2-7, 23-28, and 45-50 under 35 U.S.C. § 102(e).
3. have not established the Examiner erred in rejecting claims 18, 19, 40, 41, 61, and 62 under 35 U.S.C. § 103(a).
4. have established the Examiner erred in rejecting claims 8, 29, and 51 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's decision rejecting claims 1, 9-15, 17, 20-22, 30-37, 39, 42-44, 52-58, 60, 63, and 64 under 35 U.S.C. § 102(e).

We reverse the Examiner's decision rejecting claims 2-7, 23-28, and 45-50 under 35 U.S.C. § 102(e).

We affirm the Examiner's decision rejecting claims 18, 19, 40, 41, 61, and 62 under 35 U.S.C. § 103(a).

We reverse the Examiner's decision rejecting claims 8, 29, and 51 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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